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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,885	11/08/2000	Giovanni Chiavarotti	2000 1545	1381

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EXAMINER

RUTHKOSKY, MARK

ART UNIT PAPER NUMBER

1745

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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012304

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Commissioner for Patents

The reply brief is noted. The examiner will rely on the contents of the Examiner's Answer to show comparisons between the teachings of the applied prior art reference and the instant invention, however the examiner would like to present a short response to the applicant's comments of the reply brief.

The applicant is relying on the patentability of the parent application to show that the method of making the electrode of Yamada is different than the method of making the claimed product. The parent application, now US 6,428,842, includes a claimed process which is limited in scope as compared with the methods shown in the specification to make the claimed product of the instant application. Thus, the patentability argument is moot as the claimed, patented process cannot be held as a direct comparison to the methods shown in the specification of the instant application. From this, it is clear that simply because the method of the parent was allowed, it does not mean that the product of the instant application should also be allowed.

It is further noted that two similar and patentably distinct methods may be used to make the same product. The examiner will rely on the previous discussions of the teachings of the prior art of record as compared to the methods described in the instant application as the basis for showing that the process of making the product is equivalent. This comparison is shown in the Examiner's Answer.

With regard to the applicant's argument stating that the burden of the proof is on the Examiner to establish inherency, MPEP 2112 states, "In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." The examiner has provided a comparison of the methods in the rejection following this guideline. This is shown by comparing the methods in detail in the rejection and the remarks of the Reply Brief. The MPEP (2112) then states that, "Once a reference teaching product appearing to be substantially identical is made the basis of a rejection and the presents evidence or reasoning tending to show in herency, the burden shifts to the applicant to show an unobvious difference. This burden has not been met by the applicant as noted in the Examiner's Answer.

Mark Ruthkosky
Primary Patent Examiner
Art Unit: 1745

Mark Ruthkosky
1/22/04